



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,338	06/26/2003	Shin Nishizawa	P 0304519 H7952	5585

7590 07/07/2009  
Pillsbury Winthrop LLP  
Intellectual Property Group  
Suite 2800  
725 South Figueroa Street  
Los Angeles, CA 90017-5406

EXAMINER
----------

ZHAO, DAQUAN

ART UNIT	PAPER NUMBER
----------	--------------

2621

MAIL DATE	DELIVERY MODE
-----------	---------------

07/07/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/607,338	<b>Applicant(s)</b> NISHIZAWA, SHIN	
	<b>Examiner</b> DAQUAN ZHAO	<b>Art Unit</b> 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments filed on 3/18/2009 have been fully considered but they are not persuasive.

Applicant argues Maruyama et al fail to teach the newly added limitation "determining both an area of the optical disc at which the record information is to be recorded by the optical disc recording apparatus and an area at which the image corresponding to the image information is to be formed by the optical disc recording apparatus before recording the record information and forming the image".

However, Onodera et al teach in column 6, lines 20-67, and figures 7-8 user can determine an area for normal writing and area for label printing. For example, see figure 8, user can write "program data" to the "1a:PROGRAM AREA" as shown on figure 8 and write the label on "1b:LABEL AREA", wherein these two areas are on the same side of the disc, and both side of the disc are considered to be the recording face because side a and side b both can store data.

Applicant also argues Maruyama fail to teach the image is sequentially formed on the recording face of the optical disc by applying a laser beam.

The examiner disagrees, the image must be sequentially formed by the laser beam because there's only one laser beam (e.g. column 9, lines 55-63, pickup 38 and "semiconductor laser", which is singular). Therefore, data has to be written on the disc one unit after another unit.

Applicant argues Maruyama et al and Onodera et al fail to teach display, on display, optical disc information reflecting the record information and image which are determined by the user on the determined areas, respectively.

Maruyama et al teach e.g. column 31, lines 11-20, "if the digital information recording/playback system receives designation of a print target via the operation panel **after** the print **menu frame is displayed** on output device 46a (YES in ST3), it **instructs** the printer to print the designated print target").

### ***Specification***

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: There's no antecedent basis for the term "computer readable medium" for claims 6-14.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 6-14 are rejected under 35 U.S.C. 101 because claims are directed to non-statutory subject matter.

For claim 6, the examiner interprets the claimed "computer readable medium" as a signal, which is a non-statutory subject matter since there's no antecedent basis for the term "computer readable medium"

Claims 7-14 are also affected.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-3 and 5-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

For claims 1, 3, 6, 15-16, there's no description in the specification for "determining both an area of the optical disc at which the record information is to be recorded by the optical disc recording apparatus and an area at which the image corresponding to the image information is to be formed by the optical disc recording apparatus before recording the record information and forming the image"

Claims 2, 5, 7-14, 17-18 are also affected.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2621

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 5-9, and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Onodera et al (US 7,331,055 B2) and further in view of Maruyama et al (US 6,560,407 B2).

For claim 15, Onodera et al teach

urging a user to determine the record information to be recorded on the optical disc and the image to be formed on the optical disc (e.g. column 6, lines 20-67, user has to determine what information should be recorded on the disc and the user has to determine what label image should be printed on the disc);

determining both an area of the optical disc at which the record information is to be recorded by the optical disc recording apparatus and an area at which the image corresponding to the image information is to be formed by the optical disc recording apparatus before recording the record information and forming the image (e.g. column 6, lines 20-67, and figures 7-8 user can determine an area for normal writing and area for label printing. For example, see figure 8, user can write "program data" to the "1a:PROGRAM AREA" as shown on figure 8 and write the label on "1b:LABEL AREA", wherein these two areas are on the same side of the disc, and both side of the disc are considered to be the recording face because side a and side b both can store data ); and

displaying on the display optical disc information (e.g. column 12, lines 32-45, figures 13a and 13b).

However, Onodera et al fail to teach information reflecting the record information and the label image. Maruyama et al teach information reflecting the record information and the label image (e.g. column 30, lines 16-35). It would have been obvious to one ordinary skill in the art at the time the invention was made to incorporate the teaching of Maruyama et al into the teaching of Onodera et al to preview the label image to allow user to conveniently preview the size and position of the label image in advance (e.g. Onodera et al, column 12, lines 42-45).

Claim 16 is rejected for the same reasons as discussed in claim 15 above, wherein Onodera et al also teach an optical pickup which applies laser beam on the optical disc to record the record information on the recording face and sequentially form the image corresponding to the image information on the recording face (e.g. column 9, lines 55-63, pickup 38 and "semiconductor laser" which is not shown, the image must be sequentially formed by the laser beam because there's only one laser beam. For example, column 9, lines 55-63, pickup 38 and "semiconductor laser", which is singular. Therefore, data has to be written on the disc one unit after another unit.).

Claim 1 is rejected for the same reasons as discussed in claim 16 above, wherein Maruyama et al teach giving instructions for starting recoding of the record information and instructions for starting formation of the image corresponding to the image information to the optical disc recording apparatus after the displaying step (e.g. column 31, lines 11-20, "if the digital information recording/playback system receives designation of a print target via the operation panel **after** the print menu frame is

Art Unit: 2621

displayed on output device 46a (YES in ST3), it **instructs** the printer to print the designated print target”).

Claim 3 is rejected for the same reasons as discussed in claim 16 above.

Claim 6 is rejected for the same reasons as discussed in claim 1 above.

**Regarding claim 5**, Maruyama et al teach a step of urging the user to determine whether the recording and forming step is to be executed based on the optical disc information (e.g. user gives instruction by pressing key 5pri of the remote controller 5 in step ST1 of figure 21, also see figure 20).

**Regarding claim 7**, Maruyama et al teach a notifying function of requesting an input of setting information which is necessary for determining the recording operation and the image forming operation by the optical recording apparatus (e.g. figure 21, step ST2 shows the display print menu frame to notifying user what the printing data on the disc would be), and

wherein the operation determining step includes a step of determining the operation of recording the record information (e.g. user presses the “record button” on the remote controller) and determining the operation of forming the image in accordance with the input setting information before the instructing step (e.g. user presses the print button after the print menu frame is displayed).

**Regarding claim 8**, Maruyama et al teach a first obtaining step of obtaining an information amount of designated record information and an information amount of designated image information, and a notifying function of notifying the information amounts of the information which are obtained by the first obtaining function, and



Art Unit: 2621

wherein setting information includes at least record file information for designating record information and image file information for designating image information (e.g. column 31, lines 28-45, and figure 23c, the amount used for storing the image is considered to be the “an information amount of designated record information and an information amount of designated image information”, wherein “an information amount of designated image information” is considered not differ from “an information amount of designated record information” because the image is recorded).

**Regarding claim 9**, Maruyama et al teach the program further causes the computer to execute: a first obtaining step of obtaining an information amount of designated record information and an information amount of designated image information; a second obtaining step of obtaining a free area of the optical disc; and a notifying step of comparing a total of the information amounts of the information which are obtained in the first obtaining step with the free area which is obtained in the second obtaining step, and, when the total of the information amounts is larger than the free area, notifying that the total of the information amounts is larger than the free area, and wherein the setting information includes at least record file information for designating record information and image file information for designating image information (e.g. column 31, lines 28-45, and figure 23, user visually compares the used and unused amount in contract with each other. the amount used for storing the image is considered to be the “an information amount of designated record information and an information amount of designated image information”, wherein “an information amount

Art Unit: 2621

of designated image information” is considered not differ from “an information amount of designated record information” because the image is recorded).

**Regarding claim 2**, Maruyama et al teach the operation of recording the record information is determined after the operation of forming the image is determined (e.g. user can determine press either the “record” button or the “print” first and then the other one next).

For claims 17-18, Onodera et al teach the area which the image is to be formed is located radially outward and adjacent to the area at which the record information is recorded (e.g. see figure 8, user can write “program data” to the “1a:PROGRAM AREA” as shown on figure 8 and write the label on “1b:LABEL AREA”, Areas 1a and 1b has to be radially outward because they are located in a disc, also see figures 7a-7b).

6. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Onodera et al (US 7,331,055 B2) and Maruyama et al (US 6,560,407 B2), as applied to claims 1-3, 5-9, and 15-18 above, and further in view of Honda et al (US 7,015,939 B2).

See the teaching of Maruyama et al and Onodera et al above.

For claims 13 and 14, Maruyama et al and Onodera et al fail to teach a pattern of an image formation. Honda et al teach writing different pattern of image on the surface of the disk (e.g. see figure 12A-C, column 10, line 59- column 11, line 2, and column 2, lines 11-20). It would have been obvious for one ordinary skill in the art at the time the

Art Unit: 2621

invention was made to indicate a pattern of an image information to be form on the optical disc to obviating a necessity of the user for writing of an image performed with a pen (e.g. Honda et al, column 1, lines 35-45).

7. Claims 10, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Onodera et al (US 7,331,055 B2) and Maruyama et al (US 6,560,407 B2), as applied to claims 1-3, 5-9, and 15-18 above and further in view of Official Notice.

See the teaching of Maruyama et al and Onodera et al above.

For claims 10 and 12, Maruyama et al and Onodera et fail to teach editing the information. It is noted that editing the information is well known in the art. The examiner takes official notice for it. It would have been obvious for one ordinary skill in the art at the time the invention was made to edit the information in accordance with a result of comparison between the information amounts of the information obtained in the first obtaining step, and the free area obtained in the second obtaining step to avoid recording error due to insufficient storage space.

For claim 11, Maruyama et al teach the total of the information amounts of the information is larger than the free area as a result of the comparison between the information amounts of the information obtained in the first obtaining step and the free area obtained in the second obtaining function (e.g. column 31, lines 29-45, and figure 22 A-C, user visually compare the used and unused storage amount).

Art Unit: 2621

Applicant's amendment necessitated the new ground(s) of rejection presented in this office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEG § 706.07 (a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136 (a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period. Then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daquan Zhao whose telephone number is (571) 270-1119. The examiner can normally be reached on M-Fri. 7:30 -5, alt Fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tran Thai Q, can be reached on (571)272-7382. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Daquan Zhao/

Examiner, Art Unit 2621

/Thai Tran/

Supervisory Patent Examiner, Art Unit 2621